

R E M A R K S

Priority Under 35 USC 119

With respect to item no. 12 a) on page 1 of the Office Action (wherein the box "None" was checked), it is noted that there is one priority document. Acknowledgment of receipt of said priority document is respectfully requested.

Drawing

Although page 1 of the Office Action did not indicate that the drawing was approved, the Examiner is thanked for stating on page 4 of the Office Action that the drawing was considered and entered.

Claim Amendments and New Claims

Withdrawn claims 10, 12, 14, 16, 18, 20, 22 and 24 were canceled. Applicants reserve their right to file a Divisional application pursuant to 35 USC 121 directed to said claims.

Claim 11 was canceled, and the features of claim 11 were added to claim 13, which is now an independent claim.

The amendment to the last compound set forth in claim 15 is supported in the specification on page 17, lines 2 to 4.

Claims 17 and 25 were amended to depend on claim 13.

New claims 26 to 29 recite the first, second, third and last compounds set forth in claim 15, i.e., compounds corresponding to Compounds A, B, C and K of the present specification.

Rejection Under 35 USC 112, First Paragraph

Claims 11, 13, 15 and 25 were rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the "written description requirement" for the reasons stated on pages 4 to 5 of the Office Action.

The position was taken in the Office Action that the applicants did not specifically describe all kappa-opioid receptor agonists, except the agonist derivatives of benzothiazoline.

It is respectfully submitted that the above amendments serve to avoid this rejection.

Withdrawal of the 35 USC 112, first paragraph rejection is respectfully requested.

Obviousness-Type Double Patenting Rejection

Claims 11, 13, 15 and 25 were rejected on the ground of obviousness-type double patenting as being unpatentable over claims 2 to 4 and 6 to 7 of USP 7,410,987 to Tokai et al. for the reasons set forth on pages 5 to 6 of the Office Action.

Submitted concomitantly herewith is a TERMINAL DISCLAIMER which identifies USP 7,410,987.

Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

Obviousness Rejection

Claims 11, 13, 15 and 25 were rejected under 35 USC 103 as being unpatentable over USP 7,410,987 to Tokai et al. for the reasons set forth on pages 7 to 9 of the Office Action.

USP 7,410,987 issued on August 12, 2008 from application Serial No. 11/434,028 (published as US 2006/0205796 on September 14, 2006). Application Serial No. 11/434,028 is a continuation application of application Serial No. 10/509,549 (published as US 2005/0113430 on May 26, 2005; issued as USP 7,112,598 on September 26, 2006). Application Serial No. 10/509,549 is the United States national phase application of

International application PCT/JP03/03928 filed March 28, 2003. PCT/JP03/03928 was published in Japanese on October 9, 2003 as WO 03/082840. The earliest reference date of USP 7,410,987 and WO 03/082840 is thus October 9, 2003.

Submitted concomitantly herewith is an English-language translation of applicants' Japanese priority document (JP 2003-270967 filed July 4, 2003), along with a STATEMENT OF ACCURACY OF TRANSLATION of Mr. Akira Watanabe dated May 2, 2009.

It is respectfully submitted that applicants have thus perfected their claim for priority under 35 USC 119.

Since applicants' Japanese priority date is prior to the earliest effective reference date of USP 7,410,987 (and WO 03/082840), withdrawal of the 35 USC 103 rejection is respectfully requested.

Reconsideration is requested. Allowance is solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

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RSB/ddf

Respectfully submitted,



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Enclosures: (1) English-language translation of JP 2003-279969,  
along with a STATEMENT OF ACCURACY OF TRANSLATION  
by Mr. Akira Watanabe dated May 2, 2009  
  
(2) TERMINAL DISCLAIMER  
  
(3) PETITION FOR EXTENSION OF TIME